

REMARKS

This is a full and timely response to the outstanding Office action mailed February 10, 2005. Upon entry of the amendments in this response claims 1, 2, 4-21, and 23-28 are pending. More specifically, claims 1, 2, 4, 21, and 26 are amended. These amendments are specifically described hereinafter.

I. Present Status of Patent Application

Claims 26-28 are rejected under 35 U.S.C. § 102(e) as being anticipated by Tafoya *et al.* U.S. Patent No. 6,829,607 B1. Claims 1-25 are rejected under 35 U.S.C. § 103(a) as obvious over Tafoya *et al.* U.S. Patent No. 6,829,607 B1 in view of Oseto U.S. Patent No. 6,097,797.

II. Examiner Interview

Applicant first wishes to express sincere appreciation for the time that Examiner Vu spent with Jeff Kuester and Benjie Balser during a February 25, 2005, telephone discussion regarding the above-identified Office Action. The participants in the interview discussed whether the claimed steps associated with checking an incoming domain name list was shown in *Tafoya* or *Oseto*, and that the outcome of that discussion is addressed herein.

Applicant disagrees with the Interview Summary mailed February 28, 2005. Applicant did not indicate that “the prior art does teach ‘extract the domain name’” as alleged in the Interview Summary. While Applicant may have indicated an understanding of the Examiner’s perspective, Applicant did not agree that the element was actually taught in the reference or that the reference was prior art. Additionally, Applicant did not indicate that the cited references teach “a prompt confirme [sic] an email address if the domain is not in the domain name lists.” In asserting this position, Examiner Vu interpreted claim 1 to have more than one list. Therefore, according to Examiner Vu, “if an element is not in one list, it must be in another list.” Applicant’s Agents and Attorneys disagreed. The claims do not require more than one list. This issue is, however, addressed in amendments. The claims as amended should not be interpreted to

exclude creating multiple lists. During the conversation, Examiner Vu seemed to indicate that it would be potentially beneficial for Applicant to file this amendment and response. Thus, Applicant respectfully requests that Examiner Vu carefully consider this amendment and response.

III. Rejections Under 35 U.S.C. §102(e)

A. Claims 26-28

The Office Action rejects claims 26-28 35 U.S.C. § 102(e) as allegedly being anticipated by Tafoya *et al.* (U.S. Patent No. 6,829,607 B1). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 26 recites:

26. An e-mail communications system stored in a client computer for automatically checking for incorrect e-mail addresses provided in outgoing e-mail communications from the client computer prior to transmission to an e-mail server, comprising:

an address extractor for extracting senders' e-mail addresses from incoming e-mail communications;

a memory for storing e-mail addresses extracted from senders' e-mail addresses in incoming e-mail communications; and

a checker for searching the memory for e-mail addresses associated with intended recipients of the that are provided in outgoing e-mail communications,

wherein the checker generates a prompt for verification of the e-mail address upon detecting that an e-mail address in an outgoing e-mail communication is not present in the memory.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 26 as amended is allowable for at least the reason that *Tafoya* does not disclose, teach, or suggest at least **wherein the checker generates a prompt for verification of the e-mail address upon detecting that an e-mail address in an outgoing e-mail communication is not present in the memory.** *Tafoya* discloses “a prompt to the user to suggest adding to [sic] the contact to the user’s address book.” *See Tafoya* col.13, lines 63-64. Even if the prompt is for adding an email address to a list, the prompt is not for verification that the email address is entered correctly. Notwithstanding, no such teaching can be identified anywhere within this reference. Therefore, *Tafoya* does not anticipate claim 26, and the rejection should be withdrawn.

Because independent claim 26 as amended is allowable over the cited art of record, dependent claims 27-28 (which depend from independent claim 26) are allowable as a matter of law for at least the reason that dependent claims 27-28 contain all the steps/features of independent claim 26. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 27-28 are patentable over reference1, the rejection to claims 27-28 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 27-28 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 27-28 are allowable.

V. Rejections Under 35 U.S.C. §103(a)

A. Claims 1, 2, and 4-7

The Office Action rejects claims 1, 2, and 4-7 under 35 U.S.C. § 103(a) as allegedly being obvious over *Tafoya* (U.S. Patent No. 6,829,607 B1) in view of *Oseto* (U.S. Patent No. 6,097,797). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 recites:

1. A method of providing a system for automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:
 - creating an incoming domain name list in a memory;
 - receiving an incoming email communication;
 - extracting a domain name from a sender's email address from the incoming email communication;
 - storing the domain name in the incoming domain name list in the memory;
 - checking if a domain name of an e-mail address associated with an intended recipient of an outgoing e-mail communication is included in the incoming domain name list in the memory;*** and
 - transmitting the outgoing email communication if the domain name is included in the incoming domain name list, or otherwise generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 1 is allowable for at least the reason that neither *Tafoya* nor *Oseto* disclose, teach, or suggest at least **checking if a domain name of an e-mail address associated with an intended recipient of an outgoing e-**

mail communication is included in the incoming domain name list in the memory. *Oseto* allegedly discloses storing a domain in a list of domain names. *Tafoya* allegedly discloses searching for matches in a resolution list. However, these are two different lists with different elements. In the instant claim, an incoming domain name list is maintained and an incoming domain name list is checked to determine if the domain name in the outgoing email is included in an incoming domain name list. This is not disclosed in either *Taylor* or *Oseto*, taken individually or together. Applicant notes that claim 1 as amended should not be interpreted to exclude creating multiple lists.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 1. Notwithstanding, no such teaching can be identified anywhere within these references. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 1 is allowable.

Because independent claim 1 is allowable over the cited art of record, dependent claims 2, and 4-7 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2, and 4-7 contain all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 2, and 4-7 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2, and 4-7 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 2, and 4-7 are allowable.

B. Claims 8-17

The Office Action rejects claims 8-17 under 35 U.S.C. § 103(a) as allegedly being obvious over *Tafoya* (U.S. Patent No. 6,829,607 B1) in view of *Oseto* (U.S. Patent No. 6,097,797). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 8 recites:

8. A method of automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:

receiving email communications incoming to the email communications server;

creating a domain name database;

extracting domain names in senders' e-mail addresses from the e-mail communications incoming to the email communications server;

storing extracted domain names in the domain name database;

receiving outgoing e-mail communications from client computers connected to the e-mail communications server through a local network;

searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of the outgoing e-mail communication provided in the outgoing e-mail communications; and

generating an error prompt upon detecting that a domain name in an e-mail address provided in an outgoing e-mail communication is misspelled.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 8 is allowable for at least the reason that neither *Tafoya* nor *Oseto* disclose, teach, or suggest at least **searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of the outgoing e-mail communication provided in the outgoing e-mail communications**. *Tafoya* discloses that “the software searches for *matches* in a resolution list.” (emphasis added) *See Tafoya* col. 5, lines 3-4. However, searching for email addresses with a matching domain name is not searching for similarly spelled domain names. A similarly spelled domain name is not a matching domain name. A similarly spelled domain name is spelled differently, yet closely, to another domain name. In one non-limiting example,

“bellsouth.com” is similar to “billsouth.com.” However, these two examples of domain names are not matching.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 8. Notwithstanding, no such teaching can be identified anywhere within these references. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 8 is allowable.

Because independent claim 8 is allowable over the cited art of record, dependent claims 9-17 (which depend from independent claim 8) are allowable as a matter of law for at least the reason that dependent claims 9-17 contain all the steps/features of independent claim 8. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 9-17 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 8, dependent claims 9-17 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 9-17 are allowable.

C. Claims 18-20

The Office Action rejects claims 18-20 under 35 U.S.C. § 103(a) as allegedly being obvious over *Tafoya* (U.S. Patent No. 6,829,607 B1) in view of *Oseto* (U.S. Patent No. 6,097,797). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 18 recites:

18. An e-mail server for automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:

an interceptor for extracting domain names from e-mail addresses provided in incoming and outgoing e-mail communications;

a database generator for generating a domain name database for storing domain names extracted from senders' e-mail addresses in incoming e-mail communications; and

a checker for searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of in the outgoing e-mail communications,

wherein the e-mail server detects misspelled domain names in e-mail addresses in outgoing e-mail communications.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 18 is allowable for at least the reason that neither *Tafoya* nor *Oseto* disclose, teach, or suggest at least **a checker for searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of in the outgoing e-mail communications**. *Tafoya* discloses that “the software searches for *matches* in a resolution list.” (emphasis added) *See Tafoya* col. 5, lines 3-4. However, searching for email addresses with a matching domain name is not searching for similarly spelled domain names. A similarly spelled domain name is not a matching domain name. A similarly spelled domain name is spelled differently, yet closely, to another domain name. In one non-limiting example, “bellsouth.com” is similar to “billsouth.com.” However, these two examples of domain names are not matching.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 18. Notwithstanding, no such teaching can be identified anywhere within these references. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 18 is allowable.

Because independent claim 18 is allowable over the cited art of record, dependent claims 19-20 (which depend from independent claim 18) are allowable as a matter of law for at least the reason that dependent claims 19-20 contain all the steps/features of independent claim 18. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 19-20 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 18, dependent claims 19-20 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 19-20 are allowable.

D. Claims 21, and 23-25

The Office Action rejects claims 21, and 23-25 under 35 U.S.C. § 103(a) as allegedly being obvious over *Tafoya* (U.S. Patent No. 6,829,607 B1) in view of *Oseto* (U.S. Patent No. 6,097,797). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 21 recites:

21. A method of automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:

creating an incoming email address list in a memory;

receiving an incoming email communication;

storing, in the incoming email address list in the memory, an email address extracted from the incoming email communication;

checking if an e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the incoming email address list in the memory; and

transmitting the outgoing email communication if the e-mail address is included in the incoming email address list, or otherwise generating a prompt for a user to confirm an e-mail address if the domain name is not included in the incoming email address list.

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 21 is allowable for at least the reason that neither *Tafoya* nor *Oseto* disclose, teach, or suggest at least **checking if an e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the incoming email address list in the memory**. *Oseto* allegedly discloses storing a e-mail address in a list of e-mail addresses. *Tafoya* allegedly discloses searching for matches in a resolution list. However, these are two different lists with different elements. In the instant claim, an incoming e-mail address list is maintained and an incoming e-mail address list is checked to determine if the e-mail address in the outgoing email is included in an incoming e-mail address list. This is not disclosed in either *Taylor* or *Oseto*, taken individually or together. Applicant notes that claim 21 as amended should not be interpreted to exclude creating multiple lists.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 21. Notwithstanding, no such teaching can be identified anywhere within these references. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 21 is allowable.

Because independent claim 21 is allowable over the cited art of record, dependent claims 23-25 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 23-25 contain all the steps/features of independent claim 21. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 23-25 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 23-25 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 23-25 are allowable.

IV. Cited References Made of Record

The cited references made of record have been considered, but are not believed to affect the patentability of the presently pending claims.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 23-25 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 23-25 are allowable.

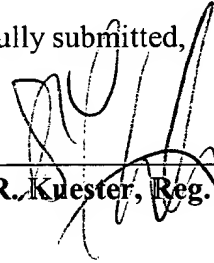
IV. Miscellaneous

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1, 2, 4-21, and 23-28 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



Jeffrey R. Kuester, Reg. No. 34,367

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500

Customer No.: 38823